

03-26-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

EXPRESS MAIL No EL 849 000 396 US.

Attorney Docket No. 50440US01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of the Application:

Service Mark	Prime Advantage
Serial No.:	75/803,859
Filed	September 20, 1999
Applicant	Sisters of Saint Francis Health Services, Inc. Mishawaka, Indiana

Sisters of Saint Francis Health Services, Inc.,)
assignee of Saint Margaret Mercy Health)
Centers, Inc.)

v.)

Prime Advantage, Inc.)

Concurrent Use No. 1212

94001212

**SISTERS OF SAINT FRANCIS' MOTION TO AMEND ITS APPLICATION
TO SEEK A GEOGRAPHICALLY UNRESTRICTED REGISTRATION AND TO
TERMINATE CONCURRENT USE PROCEEDINGS**

BOX TTAB
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

Sisters of Saint Francis Health Services, Inc. ("Sisters of St. Francis") hereby moves to amend its Application Serial No. 75/803,859 to seek a geographically unrestricted registration and to terminate the pending concurrent use proceeding because on January 31, 2003:

(1) Prime Advantage, Inc. ("Prime Advantage") sold, assigned and transferred to Sisters of

St. Francis the service mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS and Application Serial No. 75/460,711, and all rights, title and interest in and to that mark, together with all goodwill associated therewith, all rights title and interest in and to Application Serial No. 75/460,711, and any and all registration(s) that may issue therefrom; and

- (2) Sisters of St. Francis and Prime Advantage (the "Parties") entered into a Settlement Agreement, a copy of which is enclosed herewith, which fully and finally resolves the present concurrent use proceeding.

When a party to a concurrent use proceeding abandons all rights in a mark and in its application, a sole remaining party may amend its application to seek a geographically unrestricted registration.

[I]f a party to a concurrent use proceeding abandons all rights in its mark and in its application (if any), any remaining party which seeks concurrent registration may move to amend its application to delete the abandoning party as an excepted user. *If the abandoning party is the only excepted user specified in a remaining party's application, the remaining party may move to amend its application to seek a geographically unrestricted registration...*

See Trademark Trial and Appeal Board Manual of Procedure (TBMP), § 603 (emphasis added, citation omitted).

Here, pursuant to the enclosed Settlement Agreement, Prime Advantage has relinquished all rights, title and interest in and to the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS, together with all of the respective goodwill symbolized by that mark, and all rights to application and registration of that mark. Thus, as under the circumstances described in

TBMP § 603, Prime Advantage no longer has any rights, title or interest in or to the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS, nor any rights to application or registration of that mark. Further, the Parties are the only two parties to the present Concurrent Use Proceeding. Sisters of St. Francis is therefore entitled to move to amend its application to seek a geographically unrestricted registration.

Additionally, as set forth in the enclosed Settlement Agreement, any likelihood of confusion between the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS and the mark PRIME ADVANTAGE is rendered moot and precluded because both marks, all respective rights, title and interest in and to the marks, and any applications to the marks are now owned solely and exclusively by Sisters of St. Francis. (*See Settlement Agreement, at page 3.*) Prime Advantage has also agreed, pursuant to the Settlement Agreement, that it will no longer use the mark Prime Advantage Experience Has Its Rewards or any mark confusingly similar thereto. (*See Settlement Agreement, at page 3.*) Thus, because Prime Advantage has no rights, title or interest in or to the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS, and because no other person, firm, corporation, or association, besides Sisters of St. Francis, has the right to use the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the relevant services, to cause confusion, or to cause mistake, or to deceive, Sisters of St. Francis may use its mark PRIME ADVANTAGE in all proper ways, without any restriction, geographic or otherwise, and may apply for and obtain an unrestricted U.S. registration of its mark PRIME ADVANTAGE. (*See Settlement Agreement at page 3.*)

For the foregoing reasons, Sisters of St. Francis requests that its application be amended

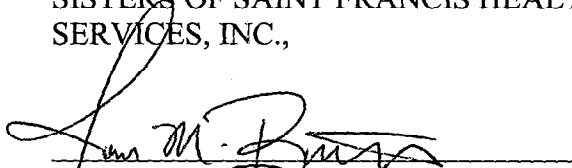
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to seek a geographically unrestricted registration, and that the present concurrent use proceeding be terminated.

Respectfully submitted,

SISTERS OF SAINT FRANCIS HEALTH
SERVICES, INC.,

Dated: MARCH 26, 2003



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CERTIFICATE OF EXPRESS MAILING

Express Mail No.: EL 849 000 396 US

Date of Deposit: March 26, 2003

I hereby certify that this **SISTERS OF SAINT FRANCIS' MOTION TO AMEND ITS APPLICATION TO SEEK A GEOGRAPHICALLY UNRESTRICTED REGISTRATION AND TO TERMINATE CONCURRENT USE PROCEEDINGS** is being deposited with the United States Postal Service's "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service in an envelope addressed to BOX TTAB, NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on March 26, 2003.

MARCH 26, 2003

Date


Signature

Joseph M. Butscher

Name

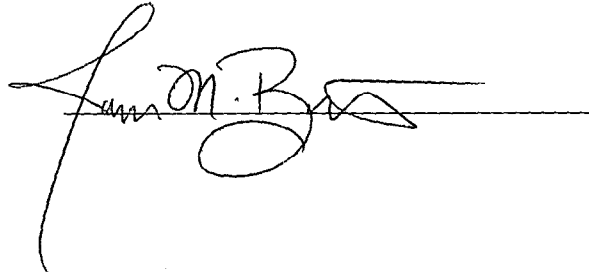
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CERTIFICATE OF SERVICE

I hereby certify that a copy of **SISTERS OF SAINT FRANCIS' MOTION TO AMEND ITS APPLICATION TO SEEK A GEOGRAPHICALLY UNRESTRICTED REGISTRATION AND TO TERMINATE CONCURRENT USE PROCEEDINGS** was served on

B. Hume Morris II, Esq.
Attorney at Law
1387 South 4th Street
Louisville, Kentucky 40208

by first class mail on March 26, 2003.

A handwritten signature in black ink, appearing to read "B. Hume Morris II", is written over a horizontal line. The signature is stylized with a large initial "B" and a long, sweeping underline.

**SETTLEMENT AGREEMENT BETWEEN
SISTERS OF ST. FRANCIS HEALTH SERVICES, INC. AND
PRIME ADVANTAGE, INC.**

The parties to this agreement, the Sisters of Saint Francis Health Services, Inc. ("Sisters of St. Francis"), a non-profit domestic corporation organized and existing under the laws of the state of Indiana, with a principal place of business at 1515 Dagoon Trail, Mishawaka, Indiana 46546, and Prime Advantage, Inc. ("Prime Advantage"), a corporation organized and existing under the laws of the State of Kentucky, having a principal place of business at 2210 Goldsmith Lane, Suite 110 Louisville Kentucky 40218 (together, the "Parties") hereby agree as follows:

BACKGROUND

The following matters have given rise to this agreement:

1. Saint Margaret Mercy Healthcare Centers ("St. Margaret Mercy"), a licensed hospital existing under the laws of the State of Indiana, having a principal place of business at 5454 Hohman Avenue, Hammond, Indiana 46320, is a wholly owned subsidiary of Sisters of St. Francis.
2. Saint Margaret Mercy is now, and has for many years been, engaged in the business of, among other things, providing, administering and sponsoring healthcare services and affinity programs.
3. St. Margaret Mercy's affinity programs comprise healthcare diagnostic, treatment, nutritional, educational and counseling services, as well as social and wellness services ("St. Margaret Mercy's Services"), which are offered and provided to affinity program members at discounted prices and/or in other preferential ways.
4. St. Margaret Mercy offers affinity program memberships to adults over the age of 60 years, for example.
5. At least as early as July 1993, St. Margaret Mercy adopted and began using in and between at least the states of Illinois and Indiana and within channels of interstate commerce its service mark, PRIME ADVANTAGE, in connection with St. Margaret Mercy's Services.
6. Saint Margaret Mercy was the owner of Illinois State Trademark Registration No. 074,993, registered as of July 28, 1994, and Indiana State Trademark Registration No. 5010-2570, registered as of August 30, 1994, for its mark PRIME ADVANTAGE for use in connection with healthcare diagnostic, treatment, nutritional, education and counseling services.

7. On April 1, 1998, Prime Advantage filed U.S. service mark application, designated by Serial No. 75/460,711, for the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS for use in connection with buying club services and claimed July 1, 1997 as its date of first use and date of first use in interstate commerce of the mark.

8. On April 26, 1999, St. Margaret Mercy filed a Notice Of Opposition to registration of Prime Advantage's mark PRIME ADVANTAGE EXPERIENCE HAS IT REWARDS, which Notice commenced Opposition No. 114,165.

9. On September 20, 1999, St. Margaret Mercy filed a U.S. concurrent use service mark application for the mark PRIME ADVANTAGE, seeking a registration encompassing the States of Illinois, Indiana and Michigan, and setting forth necessary information relating to Prime Advantage's concurrent use of the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS.

10. On September 30, 1999, St. Margaret Mercy and Prime Advantage filed a stipulated dismissal of Opposition No. 114,165 contingent upon the Trademark Trial and Appeal Board (the "Board") granting the following joint motions: (1) to amend Prime Advantage application Serial No. 75/460,711 to be geographically restricted; (2) to commence a concurrent use proceeding; and (3) to suspend, if instituted, the concurrent use proceeding.

11. On August 8, 2001, the Board mailed St. Margaret Mercy and Prime Advantage an Order in which the Board dismissed Opposition No. 114,165 without prejudice, instituted Concurrent Use Proceeding No. 1212 ("Concurrent Use Proceeding"), and suspended the Concurrent Use Proceeding pending the publication and disposition of St. Margaret Mercy's application to register the mark PRIME ADVANTAGE.

12. On December 21, 2001, St. Margaret Mercy Healthcare assigned its entire right, title and interest in and to its trademarks and service marks, including all applications for and registrations of those marks, the right to claim available rights and benefits under the International Convention for the Protection of Industrial Property and any other applicable treaties, and the rights of action and damages for past infringement of the marks, to Sisters of St. Francis, pursuant to a merger agreement effective as of December 31, 2001.

13. In connection with settling and fully and finally resolving the Concurrent Use Proceeding, the Parties are simultaneously entering into an Assignment, which is incorporated by reference herein in its entirety. Pursuant to that Assignment, Prime Advantage sold, assigned and transferred to Sisters of St. Francis the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS and Application Serial No. 75/460,711 and all right, title and interest in and to that mark, together with all of the goodwill symbolized by that mark, and the right, title and interest in Application Serial No. 75/460,711 and any and all registration(s) that may issue therefrom. Prime

Advantage further agreed, pursuant to the Assignment, to cease all use of and to never again use the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS, on or in connection with any goods or services.

THE AGREEMENT

In view of the foregoing, and in consideration of the mutual undertakings set forth herein and other good and valuable consideration, the receipt and sufficiency of which the Parties hereby accept and acknowledge, the Parties agree that:

1. Prime Advantage will not use, nor have any rights relating to, the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS.

2. Prime Advantage will not apply for any U.S., state, or other registration of the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS or a mark that is confusingly similar to that mark.

3. Prime Advantage will cease all use of and no longer use the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS or any mark that is confusingly similar to that mark on or in connection with any goods or services.

4. Sisters of St. Francis owns all right, title and interest in and to the marks PRIME ADVANTAGE and PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS, together with all of the respective goodwill symbolized by each mark, and all rights to application and registration of each mark.

5. Any likelihood of confusion between the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS and the mark PRIME ADVANTAGE is rendered moot and precluded because both marks are owned by Sisters of St. Francis.


6. Because Prime Advantage has no right, title and interest in and to the mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS, Sisters of St. Francis may use its mark PRIME ADVANTAGE in all proper ways, without any restriction, geographic or otherwise, and may apply for and obtain an unrestricted U.S. registration of its mark PRIME ADVANTAGE.

7. This agreement shall be governed and construed by and interpreted under the laws of the state of Illinois.

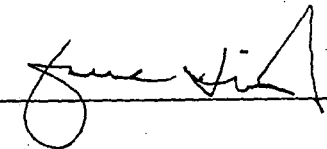
EXECUTION

In consideration of the foregoing, the parties have each caused this agreement to be signed (by their respective, duly authorized officers) on the date set forth adjacent to their respective signatures, the agreement to be effective upon execution by the Parties (that is, the date of the agreement is to be the latest execution date set forth below).

PRIME ADVANTAGE, INC.

By: 
Name: D. HUME MORRIS II
Title: Secretary
Dated: 1/31/03

SISTERS OF ST. FRANCIS HEALTH
SERVICES, INC., d/b/a SAINT
MARGARET MERCY HEALTHCARE
CENTERS

By: 
Name: _____
Title: _____
Dated: 12/12/02